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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,230	06/20/2003	Jack Q. Wilkinson	0325.210US	9796

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EXAMINER

COLLINS, CYNTHIA E

ART UNIT PAPER NUMBER

1638

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/600,230	<b>Applicant(s)</b> WILKINSON ET AL.	
	<b>Examiner</b> Cynthia Collins	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                            |                                                                                                              |
|------------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>20060623</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                                            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                                     |

### **DETAILED ACTION**

The Amendment filed June 9, 2006 has been entered.

Claims 5, 7-8 and 14-17 are cancelled.

Claims 1, 4 and 10-13 are currently amended.

Claim 6 is withdrawn.

Claims 1-4, 6 and 9-13 are pending.

Claims 1-4 and 9-13 are examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

All previous objections and rejections not set forth below have been withdrawn.

### ***Specification***

The abstract of the disclosure remains objected to because it is not descriptive of the elected invention. The title of the invention also remains objected to because it is not descriptive of the elected invention.

Applicants' arguments filed June 9, 2006 have been fully considered but they are not persuasive.

Applicants point out that the specification is amended to make the title and abstract more descriptive of the invention (reply page 8).

The objections are maintained as the amended title and abstract are still not descriptive of the elected invention.

***Claim Rejections - 35 USC § 112***

Claim 4 remains rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record set forth in the office action mailed March 9, 2006.

Applicants' arguments filed June 9, 2006 have been fully considered but they are not persuasive.

Applicants point out that claim 4 depends from claim 1, which specifies conserved structural features, and Applicants also direct the Examiner to Figure 4. Moreover, Applicants point out that a large number of sequences were disclosed and tested. Applicants specifically point out that the Examples in the specification disclose tests of nine *Saccharomyces cerevisiae*, three *Aspergillus nidulans*, one *Pichia pastoris*, and four *Homo sapiens* sequences, and Applicants urge that this disclosure provides adequate representative examples to support the pending claims. (reply page 9)

Applicants' arguments are unpersuasive. The Examples in the specification are not representative of the claimed genus, because only one of the 17 termination sequences disclosed and tested has at least 90% identity to SEQ ID NO:1 and comprises the other recited structural features, the sequence of SEQ ID NO:1.

Claims 10-12 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention, for the reasons of record set forth in the office action mailed March 9, 2006.

Applicants' arguments filed June 9, 2006 have been fully considered but they are not persuasive.

Applicants traverse the rejection and maintain that the claim language clearly indicates that the sequence identity is between two nucleotide sequences, where one of the nucleotide sequences is functional in a particular organism. Applicants point out that determining nucleotide sequence termination function from organisms is an art-recognized technique, and assert that one of ordinary skill in the art would understand the claims as currently pending. (reply page 9)

Applicants' arguments are unpersuasive, as the metes and bounds of the claimed invention cannot be determined from the limitations recited in the claims. While one skilled in the art may be able to determine nucleotide sequence termination function, the structure of the nucleotide sequences encompassed by the claims is not apparent to one skilled in the art from the claim language, because nucleotide sequences have the same chemical composition (nucleotides) regardless of organismal source, such that the determination of the structure of the nucleotide sequences encompassed by the claims would require a comparison with a particular primary nucleotide sequence, which sequence is not specified.

### ***Claim Rejections - 35 USC § 102***

Claims 1-3 and 9-13 remain rejected under 35 U.S.C. 102(b) as being anticipated by Rothnie H.M et al. (The contribution of AAUAAA and the upstream element UUUGUA to the

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efficiency of mRNA 3'-end formation in plants. EMBO J. 1994 May 1;13(9):2200-10), for the reasons of record set forth in the office action mailed March 9, 2006.

Applicants' arguments filed June 9, 2006 have been fully considered but they are not persuasive.

Applicants argue that Rothnie et al. is not relevant because it discloses the polyadenylation sequence of the cauliflower mosaic virus (CaMV), CaMV elements being excluded from the claims by the definition of "non-plant" in the specification in paragraph 40, page 9. Applicants maintain that since CaMV is a plant virus it therefore fails the limitation of "non-plant" and its polyadenylation sequence is not encompassed by the claims. (reply pages 9-10)

Applicants' arguments are unpersuasive, as the source of the claimed DNA molecule component (plant versus non-plant) does not distinguish it from other DNA molecules that have all of the specific structural limitations recited in the rejected claims, as all DNA molecules have the same chemical composition regardless of their source.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Remarks***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (571) 272-0794. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cynthia Collins  
Primary Examiner  
Art Unit 1638

CC

*Cynthia Collins* 9/6/06